

REMARKS

In the Office Action, the Examiner rejected Claims 1-4, 6, 8-11, 13-17, and 19 under 35 U.S.C. §103(a) as being unpatentable over Brandon in view of Mirville et al. Claims 5, 7, 12, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brandon in view of Mirville et al. and further in view of Levine. In rejecting the claims, the Examiner asserts that Brandon discloses an automated telephone directory. However the Examiner acknowledges that Brandon does not disclose a telephone network element that is disposed in a publicly-switched telephone network and is used to retrieve a list of parties previously called by the calling party, as recited in the pending claims. To overcome this deficiency, the Examiner asserts that it would have been obvious to modify the invention taught by Brandon in the manner taught by Mirville et al., i.e. to include functionality residing away from the telephone. In essence, the Examiner asserts that it would have been obvious to modify the stand-alone automated telephone directory device disclosed in Brandon such that it is implemented in a telephone network element that is disposed in a publicly-switched telephone network. Applicants submit that the proposed modification of Brandon is improper because it changes the principle of operation of Brandon and because Brandon teaches away from such a modification.


As Applicants noted in a previous response, Brandon discloses a modified telephone that is self-contained and that can retrieve stored information. (Col. 2, lines 25-35.) The self-contained, modified telephone is connected to the public telephone network but is not disposed within the public telephone network. (Col. 2, lines 36-39.) Indeed, Brandon makes clear that a principle objective of the invention is to provide a self-contained telephone directory system that includes all necessary components, including a central processing unit and databases. (Col. 1, line 38 - col. 2, line 8.) The self-contained nature of this invention is necessary to provide a faster and more cost efficient system architecture. (Col. 1, lines 42-49.) Thus, the principle operation of the invention

disclosed in Brandon requires that the automated telephone directory be implemented in a stand-alone telephone unit.

Despite this express disclosure in Brandon, the Examiner proposes to modify the teaching of Brandon such that functionality is removed from the telephone unit. This is contrary to Brandon's express teachings that functionality should be incorporated into the telephone unit to provide a faster and more cost efficient system architecture. Accordingly, the Examiner's proposed modification of Brandon is improper because it changes the principle of operation of Brandon. (MPEP § 2143.01) Indeed, the Examiner's proposed modification reintroduces the very same problem that Brandon sought to overcome. Moreover, Brandon teaches away from the Examiner's proposed modification in that it teaches that functionality should be incorporated into the telephone unit, not removed from the telephone unit, as the Examiner's proposed modification requires. The Examiner's proposed modification of Brandon is improper for this reason as well. Because the Examiner's proposed modification of Brandon is improper for at least these reasons, Applicants request that the Examiner's rejections of all pending claims be withdrawn.

In view of the above remarks, Applicants submit that this case is in condition for allowance. If the Examiner feels that a telephone interview would be helpful in resolving any remaining issues, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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